

REMARKS

By this Amendment, Applicants amend claims 1-3, 8-11, and 16-20, and adds new claims 21 and 22. Claims 1-22 are pending in this application.

In the Final Office Action, the Examiner rejected claims 1-4, 6-12, and 14-20 under 35 U.S.C. § 102(e) as anticipated by Tamano (U.S. Patent No. 6,032,157) and rejected claims 5 and 13 under 35 U.S.C. § 103(a) as unpatentable over Tamano in view of DeLorme et al. (U.S. Patent No. 5,848,373).

Applicants respectfully traverse the rejection of claims 1-4, 6-12, and 14-20 under 35 U.S.C. § 102(e) as anticipated by Tamano. To properly anticipate Applicants' claimed invention, the Examiner must demonstrate the presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2121 (8th ed., Aug. 2001), *quoting* Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 (8th ed. Aug. 2001), p. 2100-69.

In the Response to Arguments section of the Final Office Action, the Examiner, in referencing Figure 3 of Tamano, alleges "the boundaries of X1' and Y1' [being transformed] into second image X2' and Y2' are considered as a mathematical relationship." See page 4. While Applicants do not necessarily agree with the Examiner's allegation,¹ Applicants have amended claim 1 to recite a step of "computing

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

a georeferencing function that relates the raster map and the georeferenced map to each other, wherein the georeferencing function specifies a relationship between the image coordinates of the raster map and the geographic coordinates of the georeferenced map.” Since Tamano does not teach at least this recitation of amended claim 1, Tamano does not anticipate the claim.

As discussed in the Amendment of September 9, 2004, Figure 3 of Tamano discloses a link information table 30, which contains object numbers of the first image information 1 in a column 31, and coordinates of the objects in the first image information 1 in a column 32. In addition, object numbers of the second image information 2 are contained in a column 33, and coordinates of the objects in the second image information are contained in a column 34. The image numbers for first image information 1 are stored in the “IMAGE NO.” column 31 and the “X, Y” coordinates are stored in column 32. Predetermined values are also stored in the “IMAGE NO.” column 34 for second image information 2. See col. 5, lines 32-53. Link information table 30 thus stores a correspondence between objects of a first image and a second image.

While the Examiner alleges that “the boundaries of X1’ and Y1’ [being transformed] into second image X2’ and Y2’ are considered as a mathematical relationship” (Final Office Action at page 4), the use of a predetermined correspondence between objects that are stored in link information table 30 at least does not constitute “computing a georeferencing function that relates the raster map and the georeferenced map to each other, wherein the georeferencing function specifies a relationship between the image coordinates of the raster map and the geographic coordinates of the

georeferenced map,” as recited in amended claim 1. Accordingly, Tamano does not anticipate the claim and the Examiner should withdraw the rejection.

Independent claim 9, while of a different scope, recites features similar to those of claim 1 and therefore distinguishes over Tamano for at least the same reasons as explained above. Accordingly, Applicants request the Examiner to withdraw the rejection of claim 9, as well as the rejection of dependent claims 2-4, 6-8, 10-12, 14-20, which each depend from one of independent claims 1 and 9.

Applicants respectfully traverse the rejection of claims 5 and 13 under 35 U.S.C. § 103(a) as unpatentable over Tamano in view of DeLorme et al. (U.S. Patent No. 5,848,373). To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. Aug. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8th ed. Aug. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8th ed. Aug. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant’s disclosure. See M.P.E.P. § 2143 (8th ed. Aug. 2001).

Moreover, Applicants note that the Examiner applied DeLorme because the reference allegedly teaches using a “plurality [of] of longitude coordinates and a plurality of latitude coordinates.” See Final Office Action, page 5. Even if the Examiner’s

allegations were correct, which Applicants do not concede, DeLorme also fails to disclose or suggest at least "computing a georeferencing function that relates the raster map and the georeferenced map to each other, wherein the georeferencing function specifies a relationship between the image coordinates of the raster map and the geographic coordinates of the georeferenced map," as recited in claim 1. Since DeLorme does not make up for the deficiencies of Tamano discussed above, claims 5 and 13, which depend from allowable claims 1 and 9, respectively, are also allowable at least due to their dependence. Accordingly, Applicants request the Examiner to withdraw the rejection of claims 5 and 13 under 35 U.S.C. § 103(a) as unpatentable over Tamano in view of DeLorme.

New claims 21 and 22, which depend from claims 1 and 9, respectively, are also allowable at least due to their dependence.

CONCLUSION

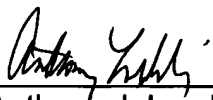
In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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